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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,745	09/30/2003	Dennis M. Hilton	621P002c/pDiv.	4209
42754	7590	07/08/2005		
NIELDS & LEMACK 176 EAST MAIN STREET, SUITE 7 WESTBORO, MA 01581			EXAMINER ZEMEL, IRINA SOPJIA	
			ART UNIT	PAPER NUMBER

1711

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/674,745

Applicant(s)

HILTON ET AL.

Examiner

Irina S. Zemel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

All of the rejections not addressed below are deemed withdrawn. Applicants should note that this application is a divisional of application 10/305991 filed November 27, 2002 which is a CIP of the application 10/044547, filed January 11, 2002. The specification of the '547 application does not provide support for the claimed "adhesive and cohesive" properties or their improvement. However, since the adherence and coherence agent is the same as the stabilizing agent disclosed in the '547 application, i.e., PVA powders, it is presumed that the claimed improvement in the adherence and coherence is inherent to the compositions. The rejection over the Burge reference is withdrawn based on the inherency assumption. Should applicants claim any specific adherence and coherence agents other than PVA or argue that the properties are not inherent to the compositions containing PVA, the rejection over Burge will be reinstated since it will be considered a valid prior art in regard to the effective filing date on the disclosure supporting use of "adherence and coherence agent", i.e., the '991 application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 13 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. While alpha-olefin **sulfonates** (normally metal salts such as sodium olefin sulfonates) are disclosed in the specification, the claimed alpha-olefin **sulfates** (entirely different compounds such as diolefin sulfates) are not disclosed anywhere in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5-10 claim amount of adherence and coherence agent in reference to the amount of another component, namely water, which is NOT a part of the claimed mixture. In fact, the water is *excluded* from the claimed *dry* mixture. The actual amount of water is NOT defined in any of the claims, or for that matter, anywhere in the specification with regard to the claimed dry components. The limitation of claims 5-10 defining the amount of the adherence and coherence agent in reference of undefined amount of water, thus, is indefinite.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-2, 5-10, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of four Ayambem et al., references cited in the previous office action.

The rejection of claims 1 and 2 stands as per reasons of record. Limitations of newly added claims 5-10 are inherently met by the Ayambem references since, as discussed above, the limitations recited in these claims are indefinite and would be met by ANY composition having any amount of adherence and coherence agent given that virtually any amount of water can be added to the composition to provide the composition with the property of pumpable slurry.

The reference expressly discloses calcium carbonate as one of the components of the mixture, and other various additives. It is the examiners position that addition of fibrous fillers is well known in the art as reinforcement fillers and thus, would have been clearly obvious for an ordinary artisan for applications where reinforced final product is desired.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ayambem in combination with applicants own admission on the record.

The Ayambem references while teaching that polyvinyl alcohols (PVA) are suitable component of the disclosed compositions, do not specifically disclose size of the of the suitable PVA powderes, thus implying that any commercially available PVA are suitable for the invention abseht showing of unexpected results that can be clearly

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attributed to the claimed powder size. Applicants admit on the record that the claimed powder size PVA are readily available on the market, and, furthermore state that "Those skilled in the art can readily determine which commercially available polyvinyl alcohol powders in addition to the foregoing are suitable", (see page 8 of the instant disclosure), thus clearly implying that the claimed PVA powders are well known and choosing it would have been obvious for an ordinary artisan with reasonable expectation of adequate results.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ayambem in combination with US Patent 5,374,448 to von Bonin (hereinafter Von Bonin).

The Ayambem references do not expressly disclose stucco as one of the possible drying-type binders, however, functional equivalence of various drying-type or hydraulic binders such as expressly disclosed gypsum or limestone, Portland cement is well known in the art and use of one in place of the other would have obvious with reasonable expectation of adequate results. This position is further supported by, for example, disclosure of van Bonin, column 2, lines 30-66. Thus, the limitations of claim 11 would have been obvious from the teachings of the above cited references.

Response to Arguments

Applicant's arguments filed 3-29-2005 have been fully considered but they are not persuasive. Applicants first argument is that the compositions disclosed by the Ayambem references necessarily contains water, while the instant invention claims dry

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compositions. However, the references clearly state that the dry component may be pre-blended. See column 7, lines 45-52 of '185 reference. (further references to specific columns and lines are all made with regard to the '185 patent). Furthermore, in the illustrative examples the drying-type joint compound (which includes, for example, gypsum as per disclosure in column 8, lines 21-26) is first dry blended with a water soluble polymeric set retarder. Addition of binders (dry components as per column 7, lines 45-52, is also within purview of the references. Therefore, dry compositions containing all the claimed elements (even though, they are disclosed as intermediate compositions) are clearly within the purview of the reference.)

The applicants argue that the Ayamem references does not disclose substrate adherence and coherence agent. However, the reference does expressly disclose addition of PVA, which, by applicants own admission on page 12 of the instant specification is the suitable "multipurpose" agent that serves as both the adherence and coherence and stabilizing agent. The applicants further argue that the reference differ from the claimed invention in the amounts of adherence and coherence agent. This argument is not persuasive for several reasons. First of all, as discussed above, the amount of the adherence and coherence agent is defined in respect of unidentified amount of water that will be added to the claimed dry composition and not with respect to the other required dry components. Thus, the amounts of adherence and coherence agent is NOT clearly defined in either the claims or the specification. Second, the functional language added to the base claims 1 "adherence and coherence agent in the amount effective for enhancing adherence and coherence to said steel substrate" is a

relative language and any amount of adherence and coherence agent would inherently provide some degree of enhancement of the claimed adherence and coherence. (See also discussion above in respect to the Burge reference).

Therefore, the invention as claimed, is still considered to have been obvious over the disclosure of the Ayambem references.

Applicants should note that a provisional double patenting rejection over claims of co-pending application 10/657,494 will likely to be issued should any of the claims of either this or the referenced co-pending application be found allowable.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

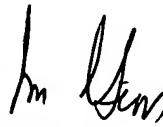
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ISZ


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